

Serial No. 10/724 339
Amendment dated November 20, 2005
Reply to Office action of May 20, 2005

Amendments to the Drawings:

The attached sheet of drawings includes changes to Fig. 2. This sheet, which is labeled "Replacement Sheet" in the top margin, replaces the original sheet of Fig. 2. In new Fig. 2 numbers 240-244 have been added. As shown, flat spots 240 and 241 are on the cam and flat spots 242-244 are on the cam lifters 210-212, respectively. An annotated sheet showing the numbers 240-244 in red is also attached.

Attachment: Replacement sheet

Annotated Sheet Showing Changes

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REMARKS

Claims 7-11 have been added, leaving claims 1-11 in the case and at issue.

The present invention relates to a new and improved automated warehouse row cart and lift for use in an automated storage and retrieval system.

In the specification the last paragraph of page 4 has been amended to correct a minor editorial problem, and the second full paragraph on page 5 has been amended to includes numbers 240-244 for the flat spots.

In amended Fig. 2 the numbers 240-244 for the flat spots have been added.

Turning now to the prior art, the Examiner rejected claims 1, 2, 5 and 6 as being unpatentable over Schroeder in view of Staar. But these references fail to provide a multiple-lobe cam, a set of cam lifters, and a transmission and motor for turning the cam relative to the elevator plate as called for in claim 1. Applicants respectfully submit that the claimed invention as a whole would not have been obvious to one of ordinary skill in the art to which the subject matter pertains at the time of the invention.

To begin with, Schroeder does not teach anything at all about a multiple-lobe cam that lifts and lowers an elevator plate. As the Examiner correctly points out, "Schroeder does not teach the lifting device as being cam operated." Schroeder transports 15,000 pound paper rolls using hydraulic means. Schroeder is very specific to roll stock which is usually tilted off a cart.

On the other hand Staar is not even a lifting device, it is a pumping device. Staar creates pressure to atomize a liquid. One of the objects of Staar "is to provide a hand held powered atomizer that externally appears similar to spray cans of the aerosol type presently being marketed," column 1, lines 46-48.

It is well known that only references from arts analogous to that of the claimed invention may comprise prior art to the invention. A reference will be analogous art if it is from the same field of endeavor as the claimed invention, or it is from a different field of endeavor, but the reference is reasonably pertinent to the particular problem solved by the inventor. See *In re Oetiker*, 977 F.2d 1443, 1446-47 (Fed. Cir. 1992) and *In re Clay*, 966 F.2d 656 (Fed. Cir. 1992). A review of Staar leads to the inevitable conclusion that this reference is not from the same field of endeavor as the claimed invention and is not reasonably pertinent to the particular problem solved by applicants. Thus, applicants respectfully submit that Staar should be withdrawn as a reference.

If the Examiner insists upon relying on the combination of Schroeder view of Staar, the Examiner has recognized that none of the references taken alone teaches the present invention.

Nevertheless, the Examiner attempts to show obviousness of the claimed invention by separating the combination applied against the claims into its component elements and then bringing the selected elements together in accordance with the pattern disclosed by applicants.

Such piecemeal fabrication of the invention of applicants from the applied references is an improper attempt to show in light of hindsight that the invention elements of applicants invention are known in the art and that these might be combined in a manner not even suggested by the references of record.

It may be proper under some circumstances to combine several references to show obviousness of the subject matter of a claim, but to be proper, the references must themselves contain such disclosure or teachings as to make the suggestion without the exercise of invention on the part of another skilled in the art. Mere conclusory statements do not adequately address the issue of motivation to combine.

In *In re Thrift*, 298 F.3d 1357, 63 U.S.P.Q.2d 2002 (Fed. Cir. 2002), the Federal Circuit vacated in part the United States Patent and Trademark Office's (PTO) determination of obviousness based on the inadequacy of the PTO's evidence of prior art.

Applicants Thrift and Hemphill filed an application for a patent directed to a voice activated hypermedia system using grammatical metadata. The system allows a user to speak or give voice commands to access the information located on the computer network and browser. Claim 1 recites a system "comprising a speech user agent; a network browsing module; and an information resource located on a computer network wherein said speech user agent facilitates voice activation of said network browsing module to access said information resource." *Id.* at 1360, 63 U.S.P.Q.2d at 2004. Independent claims 11 and 14 add the capability to create grammar and, ultimately, a "speokable hotlist" in the hypermedia system. The "speokable hotlist" give users access to a URL by, for example, asking a question.

Upon review, the examiner rejected all the claims under 35 U.S.C. § 103 as obvious, or in the alternative, as inherent over the Stefanopoulous patent and in view of the Schmandt article. With regard to claims 11 and 14, Stefanopoulous and Schmandt do not contain a teaching related to creating grammar. Instead, the examiner rejected these claims because the "use of grammar is old and well known in the art of speech recognition as a means of optimization which is highly

desirable.” *Id.* at 1362, 62 U.S.P.Q.2d at 2005. The Board of Patent Appeals and Interferences (Board) sustained the examiner’s rejection, holding that the “[e]xaminer’s reasoning is sufficient to shift the burden to Appellants to come forward with evidence and/or arguments to rebut the [e]xaminer’s position.” *Id.*

On appeal, the Federal Circuit vacated the Board’s holding that an adequate obviousness determination was made with respect to claims 11 and 14. The Federal Circuit held that the Board’s ground of rejection was inadequate because, although the use of grammar is old and well known, the decision to reject the claims as obvious was not supported by substantial evidence in light of the “unique limitations of extracting, modifying, or processing the grammar to interact with hypermedia sources.” *Id.* at 1366, 63 U.S.P.Q.2d at 2008. The Federal Circuit, quoting SEC v. Chenery Corp., 332 U.S. 194, 196 (1947), argued that if the grounds of rejection are “inadequate or improper, the court is powerless to affirm the administrative action by substituting what it considers to be a more adequate or proper basis.” In re Thrift, 298 F.3d at 1366, 63 U.S.P.Q.2d at 2008. Accordingly, the court remanded the case for further proceedings with respect to claims 11 and 14.

The Examiner combines the heavy paper roll cart of Schroeder with the hand held powered atomizer of Staar in order to arrive at the lifter of claim 1. But the motivation to combine the references is not present in the text of either reference because they are completely unrelated.

Even if it would be proper to combine Schroeder and Staar, one would still not have the invention of the applicants. One simply does not lift paper rolls weighing 7½ tons with a hand held pumping device!

Claim 1 is deemed to be in condition for allowance together with dependent claims 2-4. Claim 2 requires that the transmission and motor operate in a single direction for both lifting and

lowering of the elevator plate. Claim 3 specifies three symmetrical sided lobes while claim 4 provides flat spots on the multiple-lobe cam and cam lifters.

Regarding claim 4, Fig. 2 and the specification have been amended to include numbers 240-244 for the flat spots. Regarding claim 3, the Examiner includes more non-analogous art to show 3 lobes. Weeper relates to the continuous manufacture of hollow tubular elements. Besides, Weeper is more like a torque linear clutch which disengages. The motivation to combine Weeper with Schroeder and Staar is not present in the text of any of the references because they are completely unrelated. The same also applies to the Bernardi reference with respect to claim 4. A water conditioner valve is completely unrelated to the lifter of the applicants.

The Examiner also rejected claims 5 and 6 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of Mitchell et al 6 652 213 in view of Staar. Under this judicially created doctrine the test is whether it would have been obvious to modify the issued patent claim, or combine the issued patent claim with a teaching from the art, to arrive at the newly claimed invention. In performing this obviousness analysis, it is the issued patent claim itself, and not the disclosure of the issued patent in general, that may be used by the Examiner as a basis for comparison in an obviousness-type double patenting rejection. In re Bartfeld, 925 F.2d 1450, 1453 (Fed. Cir. 1991)

It seems that the Examiner has used the disclosure of issued patent '213 as part of the grounds for rejection since claim 11 only includes "means for depositing said palletized item at a designated position in said one row" and "means for picking up a second palletized item with said row cart." If such is the case, the double patenting rejection should be withdrawn. In addition, Mitchell claim 11 contains many items not found in instant claims 5 and 6, namely, a forklift-like attachment, a first elevator, and a second elevator, etc.

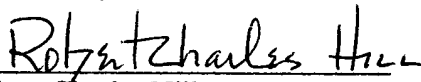
Alternatively, there is no teaching or suggestion to modify or combine the issued claim with Staar as discussed in detail above, especially since the hand held powered atomizer of Staar is not analogous art to the invention of applicants. This is also grounds for withdrawal of the double patenting rejection.

Now claims 7-11 have been added to claim the lifter in greater detail. This particular design has the ring gear attached to the base and a cooperating worm gear receiving unidirectional drive from a motor which creates continual motion to achieve a desired up and down distance of the elevator plate. In the lifter of applicants it is the triple-lobe cam that is rotating, as opposed to the fixed cam lifters which merely go up and down.

It is respectfully submitted that applicants have successfully addressed each of the concerns raised by the Examiner. Early allowance of claims 1-11 and passage of the application to issuance are earnestly solicited. Should the Examiner be of the opinion that a telephone conference with the attorney for applicants would expedite matters, he is cordially invited to contact the undersigned at the telephone number listed below.

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Respectfully submitted,


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